



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/475,147      | 12/30/1999  | ERAN ALONI           | 1795/3              | 6007             |

7590 07/22/2004

SUGHRUE MION ZINN MACPEAK & SEAS PLLC  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20037-3213

EXAMINER

BARQADLE, YASIN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2153

DATE MAILED: 07/22/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

14

|                              |                               |                              |  |
|------------------------------|-------------------------------|------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/475,147 | Applicant(s)<br>ALONI ET AL. |  |
|                              | Examiner<br>Yasin M Barqadle  | Art Unit<br>2153             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2153

**Response to Amendment**

1. The Amendment filed 04/21/04 has been entered and made of record.
2. The declaration filed on April 21, 2004 under 37 CFR 1.131 is sufficient to overcome the Skladman reference.
3. The amendment filed on 04/21/04 has been fully considered but are moot in view of the new ground(s) of rejection.
4. Claims 1-29, and 31-44 are presented for examination and pending in the application.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do

Art Unit: 2153

not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4, 6,12-29, 31-37, 43 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Cloutier et al US (6,535,586).

As per claim 1, Cloutier et al disclose a system for notifying a subscriber upon an occurrence of an event, the system comprising (abstract):

an event-generating system (Fig. 1. Server 110) for generating the event [when a new message is received an alert message is generated Col. 3, lines 33-41];

a notification request sender (Servers 110) for detecting the occurrence of the event (col. 3, lines 57 to col. 4, line 9) and for preparing a notification request according to an open network protocol [Col. 4, lines 34-60]; and

a notification server (Server 120) for receiving said notification request from said notification request sender according to said open network protocol, and for notifying the subscriber of the occurrence of the event (col. 3, lines 57 to col. 4, line 9), wherein said notification server is not in

Art Unit: 2153

direct communication with said event generating system [see fig. 1 and fig. 6].

As per claim 2, Cloutier et al teach that the event is a messaging event, and said event-generating system is a messaging system [fig. 1, email server 110].

As per claim 3, Cloutier et al teach the system of claim 2, wherein said messaging system is selected from the group consisting of e-mail and voice mail [Col. 3, lines 4-10].

As per claim 4, Cloutier et al teach the system of claim 2, wherein said messaging system further comprises an API (application programming interface) for providing an interface for detecting the event by said notification request sender [Col. 7, lines 17-40].

As per claim 6, Cloutier et al teach the system of claim 1, wherein said notification server further comprises:

an open network protocol server for receiving said notification request from said notification request sender [Col. 4, lines 27-60]; and

a notification messaging server for receiving said notification request from said open network protocol server and for notifying the subscriber of the event according to said notification request [col. 3, lines 57 to col. 4, line 9].

Art Unit: 2153

As per claim 12, Cloutier et al teach the system of claim 1, further comprising a network for connecting said notification request sender to said notification server [Fig. 1].

As per claim 13, Cloutier et al teach the system of claim 12, wherein said network is the Internet [fig. 6, 130].

As per claim 14, Cloutier et al teach the system of claim 13, wherein said event-generating system is an internal messaging system for generating a message event, said internal messaging system notifying said notification server of said message event directly [Fig. 1. Col. 3, lines 20-41].

As per claim 15, Cloutier et al teach the system of claim 13, wherein said event-generating system further comprises:

an internal messaging system (server 110) for generating a message event [when a new message is received an alert message is generated Col. 3, lines 33-41]; and

a notification request sender for sending said notification request to said notification server [col. 3, lines 57 to col. 4, line 9].

As per claim 16, Cloutier et al teach a method for notifying a subscriber (col. 3, lines 62-66) upon an occurrence of an event in an event-generating system (server 110), the method comprising:

Art Unit: 2153

(a) providing a notification server (server 120), wherein said notification server is not in direct communication with said event-generating system (server 110) [see fig. 1 and fig. 6 and col. 4, lines 7-19];

(b) detecting the occurrence of the event at the event-generating system [when a new message is received an alert message is generated Col. 3, lines 33-41];

(c) preparing a notification request according to an open network protocol [Col. 4, lines 34-60];

(d) transmitting said notification request to said notification server according to said open network protocol [Col. 3, lines 34-47 and col. 4, lines 7-19]; and

(e) notifying the subscriber of the occurrence of the event according to said notification request [col. 3, lines 57 to col. 4, line 38].

As per claim 17, Cloutier et al teach the method of claim 16, wherein said open network protocol is HTTP, and (c) further comprises preparing at least one HTTP key value pair for forming the notification message [key value pair is an inherent feature of http].

As per claim 18, Cloutier et al teach the method of claim 17, wherein said notification server is in communication with at least one associated messaging service for the subscriber, such that (e) is performed by contacting the subscriber through said

Art Unit: 2153

associated messaging service [see fig. 6 and col. 3, lines 57 to col. 4, line 38].

As per claim 19, Cloutier et al teach the method of claim 18, wherein (e) further comprises selecting a communication mode for notifying the subscriber [Col. 2, lines 30-41].

As per claims 20 and 28, Cloutier et al teach selecting a time for notifying the subscriber [Col. 5, lines 40-52].

As per claims 21 and 29, Cloutier et al teach where said communication mode and said time are determined according to the preference of the subscriber [Col. 5, lines 40-52].

As per claim 22, Cloutier et al teach the method of claim 16, further comprising:

(f) sending a first "ack" (acknowledgment) message by said notification server upon receipt of said notification request [TCP/IP (Transmission Control protocol /Internet protocol) as a standard Internet reliable protocol for the transfer of data between two computers uses delivery acknowledgment message from the network destination node to the source node for providing reliable network node-to-node delivery at the transport network protocol level Col. 5, lines 5-67 and Col. 7, lines 17-25].



Art Unit: 2153

As per claim 23, 24 and 25, these claims include similar limitations as addressed in claims 16 and 22 above. Therefore, they are rejected with the same rationale.

As per claim 26, Cloutier et al teach a method for sending a message to a subscriber by a requesting user, the method comprising:

- (a) providing a notification server (server 120);
- (b) requesting a notification of the subscriber by the requesting user, wherein a notification mechanism for notifying the subscriber is determined independently of the manner in which the request user provides notification request message [Col. 2, lines 30-49];
- (c) sending said notification request message directly to said notification server [Fig. 1. Col. 3, lines 20-41];
- (d) selecting said notification mechanism for notifying the subscriber by said notification server [col. 3, lines 57 to col. 4, line 38]; and
- (e) sending said notification to the subscriber through said notification mechanism by said notification server [Col. 2, lines 30-41].

As per claim 27, Cloutier et al teach the method of claim 26, wherein (d) further comprises the step of selecting a communication mode for notifying the subscriber [Col. 2, lines 30-41].

Art Unit: 2153

As per claim 31, Cloutier et al teach the method of claim 26, wherein the selection of the notification mechanism is based on a preference of the subscriber [Col. 5, lines 40-52].

As per claim 32, Cloutier et al teach the method of claim 26, wherein the selection of the notification mechanism is based capability of a receiving device associated with the subscriber [Col. 5, lines 24-60].

As per claim 33, Cloutier et al teach the method of claim 1, wherein the notification server selects a notification mechanism for notifying the subscriber based on at least one of a preference of the subscriber and the capability of a receiving device associated with the subscriber [Col. 5, lines 24-60].

As per claims 34, Cloutier et al teach selecting a time for notifying the subscriber [Col. 5, lines 40-52].

As per claims 35, Cloutier et al teach wherein the notification server determines whether to notify the subscriber of the occurrence of the event [Col. 5, lines 4-60].

As per claims 36, Cloutier et al teach wherein the notification server forms a notification message for notifying the subscriber based on the type of event [Col. 5, lines 4-60]

Art Unit: 2153

As per claims 37, Cloutier et al teach wherein the notification server forms a notification message for notifying the subscriber based on at least one of a preference of the subscriber and the capability of a receiving device associated with the subscriber [Col. 5, lines 4-60].

As per claim 43, Cloutier et al teaches wherein the notification request message is input by the requesting user via a web page [col. 7, lines 17-48].

As per claims 44, Nielsen teaches the method of claim 43, wherein said web page is provided by the notification server [col. 7, lines 17-48].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2153

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier et al US (6,535,586) in view of Shaffer et al US (6,094,681).

As per claim 5, Cloutier et al teaches all the limitations in claim 1 as explained above. Cloutier et al does not teach a system where the event is a non-messaging event, and where the event-generating system is a non-messaging system. However, Shaffer et al teach a system where the event is a non-messaging event such as a stock price update event notification, and where the event generating system is a non-messaging system such as a Web Server that sends stock price updates to subscribers [Col.2, lines 38-59]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the event notification system of Shaffer et al with that of Cloutier et al to have the flexibility of providing subscribers different event notifications of their choice.

7. Claim 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier et al US (6,535,586).

As per claims 7, 8 and 9 Cloutier et al teach substantially about sending e-mail notice to a notification server using TCP/IP and the Internet. Cloutier et al is silent about using File Transfer protocol (FTP), and SMTP (Simple Mail Transfer Protocol) in his system, Therefore, it would have been obvious to one of ordinary

Art Unit: 2153

skill in the art at the time of the invention to use an open network protocol such as FTP (File Transfer Protocol and SMTP (Simple Mail Transfer Protocol) to have the advantage of using a readily available standard protocols which are application and platform-independent.

As per claim 10, Cloutier et al teach the system of claim 9, wherein said notification request sender further comprises:

a notification event detector for detecting the event [col. 3, lines 57 to col. 4, line 9]; and  
a notification protocol adapter for preparing and transmitting said notification request [col. 3, lines 57 to col. 4, line 9 and col. 7, lines 14-48].

As per claim 11, Cloutier et al teach the system of claim 10, wherein said notification server further comprises a notification server protocol adapter for receiving said notification request (col. 4, lines 27-39) and for determining validity of said notification request, such that if said notification request is valid, said notification server protocol adapter passes information from said notification request to said notification messaging server [Col. 5, lines 4-60].

8. Claim 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier et al US (6,400,810).

Art Unit: 2153

As per claims 38 and 42, Cloutier et al teach the invention as explained in claims 1 and 26 above. Specifically, Cloutier et al teach an event generating system for generating events and event notification request sender for detecting the occurrence of event and for preparing a notification request according to an open network protocol as explained in claims 1 and 26 above. Further, Cloutier et al teach that the notification and remote retrieval aspects of the present invention are designed to work in conjunction with one another but also may be used independently and may be combined with other messaging system architectures (col. 3, lines 4-41). Cloutier et al is silent about teaching a detailed plurality of his system such as,

a second and third event-generating system for generating second event; and

a second and third notification request sender for detecting the occurrence of the second and third event and for preparing a notification request according to a second and third open network protocol. However, giving the teaching of Cloutier et al, it would have obvious to one of ordinary skill in the art at the time of the invention to modify Cloutier et al by having a plurality of his system for the advantage of supporting variety of messaging systems including legacy messaging systems and to accommodate large number of subscribers efficiently.

As per claim 39, Cloutier et al teach the system of claim 38, wherein said first open network protocol and said second open

Art Unit: 2153

network protocol are the same open network protocol [col. 4, lines 27-39 and col. 7, lines 17-48].

As per claim 40, Cloutier et al teach the system of claim 38, wherein at least one of said first event and said second event is a messaging event [col. 3, lines 33-41].

As per claim 41, Cloutier et al teach the system of claim 38, wherein at least one of said first event and said second event is a non-messaging event [see the rejection made on claim 5 above].

### **Conclusion**

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

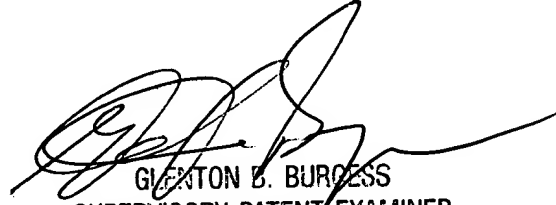
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 2153

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

Art Unit 2153



GLENDON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100